

OCT 24 2006

**REMARKS**

The Office Action has been received and carefully considered. The Office Action rejects claims 1-9 under 35 U.S.C. § 101 and rejects claims 1-12 under 35 U.S.C. § 102(b) as allegedly being anticipated by U.S. Patent No. 5,812,988 to Sandretto ("Sandretto"). Applicants respectfully traverse these rejections. Reconsideration of claims 1-12 is respectfully requested based on the following remarks.

I. The Claimed Invention Meets The Requirements of § 101

Claims 1-9 have been rejected under 35 U.S.C. § 101 as allegedly being directed to non-statutory subject matter. In particular, the Office Action posits a "two prong test" consisting of (1) a technological arts requirement, and (2) a requirement that the invention produce a useful, concrete, and tangible result. Applicants respectfully traverse this rejection as follows.

Regarding (1), the technological arts requirement, Applicants respectfully direct the Examiner's attention to *Ex Parte Lundgren*, 2003-2088 (Bd. Pat. App. Int. 2004) (precedential opinion). In that decision, the Board declared that there is no technological arts requirement under § 101. Specifically, the Board wrote: "Our determination is that there is currently no judicially recognized separate 'technological arts' test to determine patent eligible subject matter under § 101. We decline to create one." *Id.* Accordingly, any rejection over a "technological arts" requirement is improper and must be reversed.

We turn now to (2), the alleged "useful, concrete and tangible result" requirement. Applicants preface this discussion by asserting that the requirement of being "useful, concrete, and tangible"

OCT 24 2006

is not relevant to the pending claims, which are directed to a patentable business method. The "concrete, useful and tangible" requirement arose in the *State Street* opinion as an analytical tool to separate patentable subject matter from non-statutory *mathematical algorithms*. See *State Street Bank & Trust Co. v. Signature Financial Group Inc.*, 47 USPQ2d 1596 (Fed. Cir. 1998). *State Street* does not imply that business methods must satisfy the "useful, concrete, and tangible" test; rather, *State Street* mandates this test only for mathematical algorithms. The test is inapplicable to business methods such as those claimed in the pending application. Nevertheless, to ensure a complete record and expedite prosecution, Applicants state that the present claims meet the *State Street* standard for mathematical algorithms, as discussed immediately below.

A. The Pending Claims Are Directed To A Useful Invention

The claims are directed to a "useful" invention. As best understood, "useful" in this context requires some practical utility or real-world value. For the record, Applicants traverse this alleged requirement of § 101. Specifically, "practical utility" is a requirement of § 112, first paragraph, and is improperly shoehorned into an analysis under § 101. Nevertheless, the pending claims are directed to an invention with great practical utility and real-world value as discussed presently.

The claims are directed to assessing technology migration options. Independent claim 1 recites "developing the migration options with associated risks." Thus, claims 1-9 are directed to developing options for retiring old technology and adopting new technology. As is readily apparent, technology transition is a complicated and potentially costly endeavor. Any technique

that can assist in technology transition while reducing risk and expense would be highly useful. Thus, the pending claims are plainly directed to a useful invention.

B. The Pending Claims Are Directed To A Concrete Invention

As best understood, the term "concrete," in this context, means that the claimed invention produces an assured or reproducible result. Again, the pending claims plainly meet this alleged criterion. The claims are generally directed to structured development of technology transition options. There is nothing uncertain about the result recited in the pending claims. Business methods are not generally "unpredictable," as some biological arts may be. Following the method claim steps will assuredly produce the desired result: a development of migration options for a transaction enterprise. Accordingly, the pending claims are directed to a "concrete" invention.

C. The Pending Claims Are Directed To A Tangible Invention

Finally, the claims are directed to producing a "tangible," as opposed to "abstract," result. There is nothing abstract about the subject matter of the pending claims. As discussed above, following the steps recited in the claims assuredly produces a development of migration options for a transaction enterprise, along with associated risks. This real-world result assists decision makers in evaluating technology transition options. There is nothing abstract about the result produced by the claims, rather, the result is concrete and tangible: a structured development of migration options in a legacy transactional enterprise.

**II      The Claimed Invention Is Patentable Over Sandretto**

The Office Action rejects claims 1-12 under 35 U.S.C. § 102(b) as allegedly being anticipated by Sandretto. Applicants respectfully traverse this rejection as detailed below.

**A.      Sandretto Fails To Disclose A Legacy Enterprise**

There appears to be a fundamental misunderstanding as to what is claimed in the present application. The claimed invention is directed to developing options for migration of legacy enterprise technology. A "legacy enterprise" may include hardware and software. The ordinary meaning of "legacy enterprise" does *not*, however, include any type of stock, bond, or other financial instrument. For example, one application of the claimed invention is to assist in making a purchase decision for new computer equipment for an entire corporation. The claimed invention is *not* directed to making investment decisions for stocks, bonds, or other financial instruments.

Independent claims 1, 10, 11 and 12 recite a "legacy enterprise." Sandretto fails to disclose this limitation. Sandretto is instead directed to obtaining financial information on certain financial products and financial assets. Sandretto lists the types of products and assets that his invention contemplates: stocks, bonds, real estate, newly-formed companies, bankrupt companies, derivative assets, and potential assets. Sandretto, col. 9, lines 60-65. Notably absent from that list is any reference to a legacy enterprise. Sandretto does not teach, consider, discuss, suggest, or in any way refer to any type of legacy enterprise. The limitation is simply not there.

That Sandretto fails to disclose a "legacy enterprise" is unsurprising. The Sandretto patent is directed to financial analysis of a fundamentally different thing: financial instruments and financial assets. Sandretto is not in the same inventive field of endeavor as the present invention.

Under 35 U.S.C. § 102, anticipation requires that a prior art reference disclose each and every element of the claimed invention. *In re Sun*, 31 USPQ2d 1451, 1453 (Fed. Cir. 1993) (unpublished). MPEP § 2131, quoting *Verdegaal Bros. v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987), reinforces this principle: "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." Because Sandretto fails to disclose a "legacy enterprise," Applicants respectfully request that the rejections of the claims be withdrawn.

**B. Sandretto Fails To Disclose a Developin g Migration Options For A Legacy Enterprise**

The independent claims recite "developing the migration options" where the migration options are for a legacy enterprise. Sandretto completely fails to disclose this limitation.

As discussed above, Sandretto fails to disclose a "legacy transactional enterprise," let alone "developing migration options" for the same. Sandretto is directed to financial analysis of financial instruments and financial assets. Nowhere does Sandretto consider retiring old technology and adopting new technology. Sandretto does not refer to any options for changing computer systems. There is no discussion, consideration, teaching, or reference to developing migration options in Sandretto. Sandretto is directed to a completely different art: financial

analysis of financial products and financial assets. As such, reliance on Sandretto for disclosure of developing migration options for a legacy enterprise is misplaced.

As discussed above, 35 U.S.C. § 102 requires that a prior art reference disclose each and every element of the claimed invention. *In re Sun*, 31 USPQ2d 1451, 1453 (Fed. Cir. 1993) (unpublished). MPEP § 2131, quoting *Verdegaal Bros. v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987), reinforces this principle: "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." Because Sandretto fails to disclose "developing the migration options" of a legacy enterprise, Applicants respectfully request that the rejections of the claims be withdrawn.

### III. The Office Action in General

For the record, Applicant states here some concerns regarding the Office Action. In general, it is difficult to discern exactly what portions of the cited reference that the Examiner relies upon. For example, the Examiner repeatedly cites nearly seven pages from the applied patent as meeting certain claim limitations. See, e.g., Office Action, page 3 (citing columns 15-28 as allegedly meeting the last two limitations of claim 1). Further, the Examiner cites *nearly twenty columns* in the rejection claim 1, which is only eleven lines long, without any analysis whatsoever. The Examiner copies the claim limitations into the Office Action without discussing how the voluminous citations allegedly meet the individual claim limitations. Applicants are adversely prejudiced because the rationale for rejection is effectively obscured or buried.

Further, the Office Action fails to properly consider each individual claim limitation. For example, the Office Action cites the same *fourteen columns* of Sandretto as allegedly meeting claims 2-6 and 9, each of which is only two lines long. Merely reproducing the claim limitations word-for-word in the Office Action without any accompanying analysis, other than voluminous citations, does not adequately give Applicants notice as to how the Examiner views the rejections. U.S. Patent Office policy demands that each claim limitation be considered and addressed, and Applicant requests the same. See *In re Lcwry*, 32 F.3d 1579, 32 USPQ2d 1031, 1034 (Fed. Cir. 1994) (citing *In re Gulack*, 703 F.2d 1381, 217 USPQ 401, 405 (Fed. Cir. 1983)); see also *In re Wilson*, 424 F.2d 1382, 165 USPQ 494, 496 (CCPA 1970) ("All words in a claim must be considered in judging the patentability of that claim against the prior art.").

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APPLICATION NO. 09/894,476  
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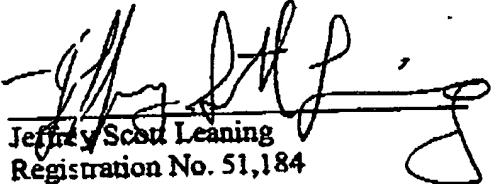
IV. Conclusion

In view of the foregoing, it is respectfully submitted that the present application is in condition for allowance, and an early indication of the same is courteously solicited. The Examiner is respectfully requested to contact the undersigned by telephone at the below listed telephone number, in order to expedite resolution of any issues and to expedite passage of the present application to issue, if any comments, questions, or suggestions arise in connection with the present application.

Applicant believes that no fee is required for entry of the present Reply. Nevertheless, in the event that a variant exists between the amount tendered and that determined by the U.S. Patent and Trademark Office to enter this Reply or to maintain the present application pending, please charge or credit such variance to the undersigned's Deposit Account No. 50-0206.

Respectfully submitted,  
HUNTON & WILLIAMS LLP

By:

  
Jeffrey Scott Leaning  
Registration No. 51,184

Dated: December 9, 2005

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OCT 24 2005

## EXHIBIT A

REVOCATION OF PREVIOUS POWERS OF ATTORNEY AND APPOINTMENT OF  
NEW POWERS OF ATTORNEY AND CHANGE OF CORRESPONDENCE ADDRESS

Pursuant to 37 C.F.R. § 3.73(b), the undersigned, who is empowered to act on behalf of the Assignees of the applications and patents listed in Schedule A, hereby certifies that, to the best of Assignee's knowledge and belief, title to the said applications and patents is with said Assignees listed in Schedule A.

Accordingly, Assignees hereby revoke any and all previous Powers of Attorney in the applications and patents listed in the attached Schedule A, and hereby appoint, both jointly and severally, as attorneys and agents with full power of substitution and revocation, to prosecute the applications and patents in Schedule A, including any and all continuation, divisional, renewal, substitute, reexamination and reissue applications based in whole or in part on said patent application, before the U.S. Patent and Trademark Office, to transact all business in the U.S. Patent and Trademark Office connected therewith, including receiving any Letters Patent issuing thereon, and to take any and all other legal action with regard to the applications and patents listed in Schedule A, the registered patent attorneys and agents associated with:

**CUSTOMER NUMBER 21967**

All correspondence and telephone communications should be addressed to:

**CUSTOMER NUMBER 21967**

which corresponds to the following:

Intellectual Property Department  
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Nov-05-05 18:27

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T-522 P-83/04 F-870

The newly appointed registered patent attorneys and agents of Huston & Williams are hereby authorized to make all necessary filings with the U.S. Patent & Trademark Office to make this appointment of Powers of Attorney of record for each of the individual applications and patents listed in Schedule A.

Dated: 11/7/05

By: 

Andrew Cudel, Esq.  
Managing Director, Associate General Counsel  
JPMorgan Chase & Co.,  
authorized signatory for  
JPMorgan Chase Bank, N.A.,  
successor in interest to Assignees  
Morgan Guaranty Trust Company of New York  
JPMorgan Chase Bank, N.A.  
The Chase Manhattan Bank

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PAGE 34 \* RCVD AT 11/9/2005 4:26:51 PM [Eastern Standard Time] \* SVR:RURGHTFAX11 \* DNI:22211 \* CSID:+3022828381 \* DURATION (mm:ss):02:30

PAGE 13/14 \* RCVD AT 10/24/2006 3:07:08 PM [Eastern Daylight Time] \* SVR:USPTO-EFXRF-1/17 \* DNI:2738300 \* CSID:+2027782201 \* DURATION (mm:ss):03:48

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T-822 P-04/14 F-670

## Schedule A

Application No.	Docket Number (Filing or New) 72187.000564	Filing Date 08/10/2001	Patent No. 091102001	Patent Issue Date 08/12/2002	Assignee Morgan Guaranty Trust Company of New York
1013634.118	36287.02701 [new] 72187.000564	11/30/2000	091231002	09/23/2002	JPMorgan Chase Bank Morgan Guaranty Trust Company of New York
101252.936	36287.000564 [new] 72187.000564	01/29/2001	10/14/2005	09/16/1998	JPMorgan Chase Bank The Chase Manhattan Bank
093894.476	36287.02490 [new] 72187.000564	2554.72 [new] 72187.000564	03/14/2003	09/16/1998	JPMorgan Chase Bank
101154.131	36287.02680 [new] 72187.000564	36287.02680 [new] 72187.000564	12/05/2007	12/05/2007	JPMorgan Chase & Co.
1013637.566	36287.02680 [new] 72187.000564	36287.02680 [new] 72187.000564	11/12/2002	11/12/2002	JPMorgan Chase & Co.
1010485.817	36287.02200 [new] 72187.000564	36287.02200 [new] 72187.000564	05/25/2002	05/25/2002	JPMorgan Chase Bank
101154.129	36287.020562 [new] 72187.000564	36287.020562 [new] 72187.000564	08/27/2002	08/27/2002	Morgan Guaranty Trust Company
1010684.721	36287.020561 [new] 72187.000564	36287.020561 [new] 72187.000564	08/24/2001	08/24/2001	JPMorgan Chase & Co.
1012611.256	36287.020560 [new] 72187.000564	36287.020560 [new] 72187.000564	01/01/2003	01/01/2003	JPMorgan Chase Bank
1013638.938	36287.020562 [new] 72187.000564	36287.020562 [new] 72187.000564	02/25/2003	02/25/2003	JPMorgan Chase Bank
1010718.587	36287.020562 [new] 72187.000564	36287.020562 [new] 72187.000564	02/18/2002	02/18/2002	JPMorgan Chase Bank

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